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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,417	09/22/2003	Robert J. Small	60937-0215-US	6517

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/665,417

Applicant(s)

SMALL ET AL.

Examiner

Michael A. Marcheschi

Art Unit

1755

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 37, 42-59 and 74.
Claim(s) objected to: _____.
Claim(s) rejected: 60, 64, 68-73 and 75.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Michael A. Marcheschi
Primary Examiner
Art Unit: 1755

Continuation of 3. NOTE: applicants amendment to claim 70 defines new matter because the specification only defines the recited pH for composition that contains benzotriazole in addition to the claimed components. Since the claim lacks the essential benzotriazole component, it is new matter. The claimed pH was never defined for the two component system of the claim .

Continuation of 11. does NOT place the application in condition for allowance because applicants argument with respect to the new matter of claim 68 is not persuasive since this claim was never defined before as previously set forth in the last office action. Although broad oxidizers are defined, the claimed combination is not literally defined. This is the same concept as claiming a narrow range that was not literally defined. Since the combination was not specifically defined, it is not supported. With respect to claim 60 and 64, applicants argue the oxidizers defined by Mandigo et al., Easter et al and Imai et al. The examiner has addressed the oxidizers of these references in the last office action. Applicants argue that Uchikura et al. does not teach aluminum nitride. Although not specifically defined, the reference implies this as is clearly set forth in the previous office action. With respect to the motivation, this to was clearly defined in the last office action . Applicants appear to be arguing that the pH precludes such a combination. The examiner is unclear as to this argument because the pH is based on the entire composition or the use of the composition and not on the oxidizer alone, and applicants have not shown that the combination, as defined by the examiner, can not be made in composition having different pH values (i.e. the primary references do not exclude other oxidizers and applicants have not shown clear evidence that the references would exclude the combination applied). Are applicants stating that aluminum nitrate oxidizers can not be used at a pH values different than that disclosed by Uchikura et al.? With respect to claims 68-72, applicants have not clearly argued the examiners reasons for the rejections based on Imai et al. or Ester et al. both in view Uchikura et al. Applicants appear to be arguing that both primary references are outside the scope of "consisting essentially of" yet fail to provide sufficient evidence to support this. The rejection of claims 68-72 over Mandigo is withdrawn in view of applicants remarks.